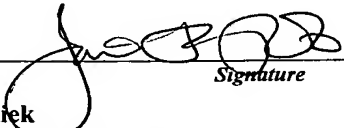



| | | | | | |
|--|-------------------------------------|-----------------------------|--------------------------------|-----------------------------|-------------------|
| AMENDMENT TRANSMITTAL LETTER (Large Entity) | | | | Docket No. PG4709 | |
| Applicant(s): BIGGADIKE, et. al. | | | | | |
| Serial No. 10/066,964 | Filing Date 02/04/2002 | Examiner BADIO | Group Art Unit 1616 | | |
| Invention: FORMULATION CONTAINING ANTI-INFLAMMATORY ANDROSTANE DERIVATIVES | | | | | |
| <u>TO THE COMMISSIONER FOR PATENTS:</u> | | | | | |
| Transmitted herewith is an amendment in the above-identified application. The fee has been calculated and is transmitted as shown below. | | | | | |
| CLAIMS AS AMENDED | | | | | |
| | CLAIMS REMAINING AFTER AMENDMENT | HIGHEST # PREV. PAID FOR | NUMBER EXTRA CLAIMS PRESENT | RATE | ADDITIONAL FEE |
| TOTAL CLAIMS | 19 - | 19 = | 0 x | \$18.00 | \$0.00 |
| INDEP. CLAIMS | 1 - | 1 = | 0 x | \$84.00 | \$0.00 |
| Multiple Dependent Claims (check if applicable) <input type="checkbox"/> | | | | | \$0.00 |
| TOTAL ADDITIONAL FEE FOR THIS AMENDMENT | | | | | \$0.00 |
| <div style="display: flex; justify-content: space-between;"> <div style="width: 60%;"> <input checked="" type="checkbox"/> No additional fee is required for amendment. <input type="checkbox"/> Please charge Deposit Account No. _____ in the amount of _____ <input type="checkbox"/> A check in the amount of _____ to cover the filing fee is enclosed. <input checked="" type="checkbox"/> The Director is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 07-1392 <input checked="" type="checkbox"/> Any additional filing fees required under 37 C.F.R. 1.16. <input checked="" type="checkbox"/> Any patent application processing fees under 37 CFR 1.17. </div> <div style="width: 35%; text-align: right;"> Dated: 6 Nov 2003 </div> </div> | | | | | |
| <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;">  _____ Signature Jim Riek Registration No.: 39,009 Telephone: 919-483-8022 Customer No.: 23347 </div> <div style="width: 50%; border: 1px solid black; padding: 5px;"> <p>I certify that this document and fee is being deposited on 11/06/03 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</p> <p style="text-align: center;"> Signature of Person Mailing Correspondence</p> <p style="text-align: center;">Ban Younan Typed or Printed Name of Person Mailing Correspondence</p> </div> </div> | | | | | |
| CC: | | | | | |



IN THE UNITED STATES PATENT OFFICE

Applicant : Biggadike, et al.
Application No. : 10/066,964
Filed : 2/4/02
Title : Formulation Containing Anti-Inflammatory Androstane Derivatives

Grp./A.U. : 1616
Examiner : BADIO, Barbara P.

Docket No. : PG4709

Commissioner of Patents
Washington DC 20231

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Response to Official Action of 10/03/03

The following is in response to the Official Action of October 3, 2003.

1. Double Patenting Issues Mooted by Filing of Terminal Disclaimers

Applicant, in an effort to promote allowance of the case, has attached terminal disclaimers over the co-pending applications of record. As such the rejections of the claims of this application over the claims of US Serial Nos. 10/066,836, 10/067,020, 10/241,658, and 10/200,364 are rendered moot. The withdrawal of these rejections is therefore appropriate.

The present disclaimers are provided solely in an effort to further prosecution and without prejudice. Applicant points out that these disclaimers have no effect on the actual term of any patent resulting from this application. The patents resulting from each of the disclaimed cases would have expired on the same date as a patent issuing from this application, even in the absence of the disclaimer. In filing these disclaimers, applicant specifically reserves the right to address any double patenting and/or obviousness issues in the future. Applicant makes particular note of MPEP 804.02 II and established case law findings of the Federal Circuit, in Quad Environmental Technologies v. Union Sanitary District, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991), that the filing of a terminal disclaimer to obviate a rejection based on a non-statutory double patenting is not an admission of the propriety of the rejection. The filing of a terminal disclaimer simply serves the statutory function of

removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.

2. Information Disclosure Statements

Applicant has received initialed copies of the 1449s accompanying the IDSs filed on 8/1/03 and 5/1/02.

However, applicant has not yet received copies of the 1149 that accompanied the IDS filed on 9/3/02 (listing refs. CB, CC). Copies of these papers as filed with the Patent Office, as evidenced by the stamped postcard, are included herewith in the event that they have been misplaced.

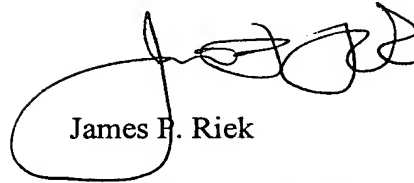
Also accompanying this Response is a further Supplemental IDS. US Patents and US Patent Application Publications have not been included, as allowed under current IDS practice. Copies of other references are attached as .pdf files on the enclosed compact disk.

Applicants respectfully assert that the pending claims are inventive and are in a condition for allowance. Applicant requests that a timely Notice of Allowance be issued in this case. If any matters exist that preclude issuance of a Notice of Allowance, the examiner is requested to contact the applicant's representative at the number indicated below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge any fees or credit any overpayment, particularly including any fees required under 37 CFR Sections 1.16 and/or 1.17, and any necessary extension of time fees, to deposit Account No. 07-1392.

Respectfully submitted,

Dated: 6 Nov 2003

A handwritten signature in black ink, appearing to read "James P. Riek", is written over a circular stamp or seal.

James P. Riek

Attorney for Applicant
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Fax. (919) 483-7988